

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Alex Bellehumeur

Filing Date: January 24, 2002

Reissue Application Serial No.: 10/057,671

Title: PUCK FOR USE ON A
NON-ICE SURFACE

REISSUE LITIGATION

Group Art Unit: 3711

Examiner: Raleigh Chiu

August 8, 2002

Commissioner of Patents and Trademarks
Washington, D.C. 20231

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GROUP 3700

Dear Sir:

RESPONSE TO PROTEST UNDER 37 CFR 1.291(a)

Comments by Applicant to Protest

In response to the Office Communication dated July 31, 2002, applicant submits the following comments on the Protest filed by Mr. Steven L. Permut:

The first issue raised in the Protest is entitled "TERMINAL DISCLAIMER." It asserts that "the deliberate filing of a terminal disclaimer to overcome a double patenting rejection is not an error to the specification or claims under 35 USC §257." Initially, applicant asserts that an error in the terminal disclaimer filed is the basis of the reissue, not the filing of the terminal disclaimer. The U.S. Patent and Trademark Office Board of Patent Appeals and Interferences discussed the reissue statute and pointed out that it has been sanctioned on several occasions to correct defects in patents that were not the result of errors

Claims. The following summary is set forth on page 1696 of Ex Parte Hipkins (BD Pat.App. & Int.1991) 20 USPQ2d 1694:

"In keeping with the remedial nature of the statute, reissue has been sanctioned on several occasions to correct defects in patents that were not the result of errors in the specification, drawings or claims. For example, see *Brenner, Comr. Pats. V The State of Israel*, 400 F.2d 789, 158 USPO 584 (D.C. Cir. 1968)(reissue granted where deceptive intent not an issue and where the only ground urged was failure to file a certified copy of the original foreign application to obtain the right of foreign priority under 35 USC 119 before the patent was granted); *Sampson v. Comr. Of Pats.*, 195 USPO 136 (D.D.C. 1976)(patentee entitled to have amendments enter under §§120 and §§225 for limited purpose of correcting filing dates of prior abandoned applications in chain, where invention is not challenged and equity so dictates); *A.F. Stoddard & Co., Ltd. v. Dann, Comr. Pats.*, 564 F.2d 556, 195 USPO 97 (D.C. Cir. 1977) (although not expressly authorized by Title 35, patent owner is entitled to correction substituting true inventor for innocently by incorrectly named inventor by reissue of issued patent); *In re Bennett*, 766 F.2d 524, 226 USPO 413

(Fed. Cir. 1985) (defective execution of a timely filed reissue application seeking to obtain broader claims may be corrected after two year period for filing a broadening reissue has passed). Thus, the case law clearly indicates that a change in the language of the patent's specification, drawings or claims is not an absolute prerequisite for correction of a defective, inoperative or invalid patent under 35 USC 251 if it be established that the error arose without any deceptive intention."

Thus, the reissue would appear to be the appropriate procedure to correct an erroneous Terminal Disclaimer filed without any deceptive intention.

The protestor cites the case of Ex parte Anthony, et al. 230 USPQ 467 (PTOBA, 1982, released 1986). Although this case does involve a reissue application and a terminal disclaimer, it is not relevant to the present reissue application. In the Anthony, et al. case, the issue in the case is set forth distinctly at page 468 in the first full paragraph as follows:

"The only outstanding rejection against the claims is under 35 USC 251. The principal issue raised by the rejection is whether or not the statute provides for the granting of a reissue patent for the sole purpose of, in effect, withdrawing or canceling a terminal disclaimer filed during the prosecution before the Patent Examiner of the application which resulted in the granting of the patent for which the present application seeks a reissue."

The Court in the Anthony case stated at page 469, in the first full paragraph of the second column:

"From the record, it would appear that the appellants acquiesced in the rejection. Under these circumstances, we do not believe the filing of a terminal disclaimer constitutes 'error' within the meaning of §251."

The sentence bridging pages 469 and 470 states:

"The deliberate filing of the terminal disclaimer to overcome the rejection cannot now be considered as such an error as contemplated by 35 USC 251 to permit the reissuance of a patent in order to cancel or withdraw the terminal disclaimer."

And finally, at page 470 in the third to last paragraph:

"We are also of the view that the reissue application is not here proper since, in effect, the granting of the reissue would enlarge the scope of the claims of the original patent. The claims would be able to be sued upon for a longer period than would be the claims of the original patent."

Thus, in the Anthony, et al. case the patentee was trying to enlarge the life of his patent which when it was issued would have been good for 17 years from the date of issue and the terminal disclaimer shortened this time period. Thus, he was attempting to cancel or withdraw the terminal disclaimer, which is not at all the action or subject of the present reissue.

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application. Instead, in the present reissue application, applicant wishes to correct an error in the terminal disclaimer, not withdraw it.

The second issue raised in the protest was the allegation that there was "NO SHOWING OF DILIGENCE." While it is necessary to file a broadening reissue application within two years of the granting of a patent, there is no such requirement for a reissue which does not seek to broaden the claims.

As set forth in the Declaration of Edgar W. Averill, Jr., the undersigned, in his best recollection and after a search of his time records, became aware of the error in the terminal disclaimer sometime after October 24, 2001, the date a motion for summary judgment was signed by Attorney Emma L. Forest, Esq. The motion for summary judgment was filed in the case of Alex Bellehumeur v. Carl Lekavich, et al., Case No. CV-01-00138 RWSL. The present reissue application was filed well within a year of the time of the discovery of the error by the undersigned and there is no attempt to broaden the claims.

Also attached hereto is a Declaration of Alex Bellehumeur, stating that he was not aware of the error in the terminal disclaimer before October 24, 2001. Protestor cites the 3rd Circuit 1942 case of General Radio Co. v Allen B. DuMont Laboratories, 129 F.2d 608. This case states at page 613:

"The question, therefore, is whether a delay of more than 8 years in making application for reissue was reasonable. Because of varying circumstances, there can, of course, be no fixed rule as to the time in which an application for reissue must be made.

What is a reasonable time under the circumstances is to be determined by the Court."

In the present circumstances, it would seem clear that the date the error was discovered would provide a start time for a period of reasonableness and this date, at its earliest, is October 24, 2001, less than one year from the filing of the present reissue application.

The Board of Patent Appeals and Interferences in Ex parte Lafferty, Tedeschi & Zirkle, (BdPatApp&Int 1975) 190 USPQ 202 provides a very succinct statement at the sentence bridging pages 203 and 204 as follows:

"Accordingly, we hold that, in the absence of equitable considerations, an application for a narrowed reissue may not be denied on the grounds of delay or lack of diligence in filing the reissue application."

It is not seen that any equitable considerations exist in the present reissue application, and thus, it is believed clear that this reissue application should not be denied on the basis of lack of diligence.

The next issue is entitled "IMPROPER ENLARGEMENT OF SCOPE OF PATENT AFTER TWO YEARS."

This issue is set forth by the Protestor in two sentences:

"Furthermore, by eliminating the terminal disclaimer, it is argued that he is broadening the protection by increasing the

duration of the patent. Therefore, the vertical scope is improperly enlarged."

This is a puzzling argument for many reasons, two of which are: we are not attempting to eliminate the terminal disclaimer, but to correct it. Even if the terminal disclaimer were eliminated, it would not increase the life of the patent, since the patent expires with or without the terminal disclaimer when the parent application expires under the present 20 years from filing patent life. Clearly, there is no enlargement of the scope of the patent involved in the present reissue application.

The next issue is entitled "NO CORRECTION OF OWNERSHIP."

As set forth on the front page of the '161 patent, the '161 patent is a continuation of serial No. 303,589, abandoned, which is a continuation of serial No. 150,420, abandoned, which is a division of serial No. 949,077, patent No. 5,275,410. MPEP §306 states in part:

"In the case of a division or continuation, the prior assignment recorded against the original application is applied to the division or continuation application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications."

The Protestor seems to argue that the existence of application serial Nos. 150,420 and 303,589 somehow mean that the assignment of the '410 patent had no effect on the application which matured into the '161 patent. He cites no authority for this proposition. It would appear,

however, from the clear reading of §306, that the '410 patent is the "original application" and should be applied to the division or continuation applications and issued patent.

The Protestor also alleges that the Patent and Trademark Office made a mistake to apply the February 8, 1996, assignment to the then existing application and its later continuation. It is submitted that an assignment of the '410 patent was properly applied against the applications which matured into the '161 patent as specifically set forth in §306.

The next issue in the protest is entitled "VIOLATION OF DUTY OF CANDOR UNDER RULE 56." Under this issue, the protestor alleges that Mr. Bellehumeur had a duty of disclosure to the examiner of the assignment of the '410 patent to "another entity." The protestor cites no authority for the existence of a duty to inform the examiner of a change of ownership of a parent patent.

If such a duty does exist, which is not conceded, it is hard to see how Mr. Bellehumeur would have any knowledge of such a duty and, clearly, the undersigned was not aware of the change in ownership, and furthermore, is not aware of a duty to keep the examiner informed as to the ownership of a parent patent.

Next, the Protestor alleges that Mr. Bellehumeur had knowledge of the ineffective January 1996 terminal disclaimer. Mr. Bellehumeur's declaration states that Mr. Bellehumeur was not aware that the 1996 terminal disclaimer was erroneous. Furthermore, since the assignment of the '410 patent changes the ownership of the application which matured into the '161 patent, there was never any split in ownership between the '410 patent and the applications which matured into the '161 patent. Thus, the undersigned can see no basis for a

duty on the part of an inventor to inform the examiner of a change in ownership of a parent patent.

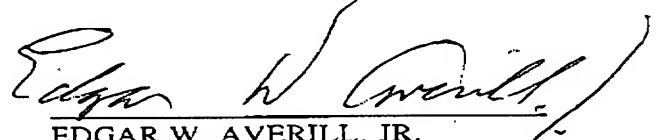
The next issue is "NO PROPERLY SIGNED OATH." It is believed that this issue has been resolved by the filing of a corrected oath which includes the signature of Mrs. Linda Dyer-Bellehumeur.

The next issue is "WRONG INVENTORSHIP." Under this heading the Protestor refers to "serious evidence" raised during litigation and the issue of inventorship is clearly an issue which is more readily decided after hearing testimony or viewing affidavits filed by others who claim to have invented the runner concept rather than in this reissue application. If the patent is reissued, the issue of inventorship will still be available to defendants in court. It is, thus, believed an inappropriate issue to be decided in the present reissue application.

SUMMARY

It is believed that none of the issues raised in the Protest lead to a conclusion that a reissue is improper. Reissuance of the '161 patent with a corrected terminal disclaimer is respectfully requested.

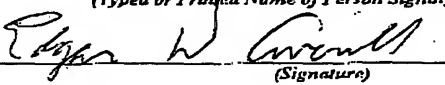
Respectfully requested,



EDGAR W. AVERILL, JR.

Reg. #24,752

Attorney for Applicant

CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)			Docket No.
Applicant(s): Alex R. Bellehumeur			133/148
Serial No. 10/057,671	Filing Date 1/24/02	Examiner R. Chiu	Group Art Unit 3711
Invention: Puck for Use on a Non-Ice Surface			
<p style="text-align: right;">FAX RECEIVED AUG 14 2002 GROUP 3700</p> <p>I hereby certify that this <u>Response to Protest Under 37 CFR 1.291(a)</u> (Identify type of correspondence) is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. <u>703/305-3579</u>)</p> <p>on <u>August 14, 2002</u> (Date)</p> <p style="text-align: right;"><u>Edgar W. Averill, Jr.</u> (Typed or Printed Name of Person Signing Certificate)  (Signature)</p> <p style="text-align: center;">Note: Each paper must have its own certificate of mailing.</p>			